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DEC 28 2006

Atty. Docket No. CA1457
PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/783,163

REMARKS

Claims 1-20 are all the claims pending in the application. Independent claims 1, 6, 10 and 19 are being amended. No new matter has been introduced.

Telephonic Interview

Applicants thank the Examiner for courtesies extended to Applicants during Examiner's interview with Applicants' representative, which took place on December 27, 2006. During the interview, the Applicants' representative and the Examiner discussed the claim rejections under 35 U.S.C. §103, the prior art of record and the proposed claim amendments presented herein.

The Examiner has requested Applicants to present the proposed amendments in a written response for Examiner's consideration.

It is respectfully submitted that the instant STATEMENT OF SUBSTANCE OF INTERVIEW complies with the requirements of 37 C.F.R. §§1.2 and 1.133 and MPEP §713.04.

It is believed that no fee is necessary.

Claims Rejections Under 35 U.S.C. §112

The Examiner has rejected claim 1 under 35 U.S.C. §112, second paragraph, as being allegedly indefinite. In response, without admitting that claim 1 was indeed indefinite, Applicants amend the rejected claim 1 and respectfully submit that the aforesaid amendment overcomes the Examiner's rejection. Thus, the amended claim 1 is patentable.

Claims Rejections Under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-20 under 35 U.S.C. §103(a) as being allegedly unpatentable over Axberg et al. (U.S. patent No. 6,253,240) in view of Saegusa et al. (U.S.

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patent No. 6,745,281). Applicants respectfully traverse this rejection in view of Applicants' amendments to independent claims 1, 6, 10 and 19 and further in view of the following arguments.

Specifically, the amended claims 1, 6, 10 and 19 generally recite a feature of the claimed invention, which involves receiving at said storage subsystem an I/O command to access storage resources from the host; determining whether storage resources requested by the I/O command are usable by searching a device management table; performing said I/O command, if the storage resources requested by the I/O command are usable, otherwise rejecting the I/O command; and sending an I/O result to the host. Without admitting that Axberg et al. and Saegusa et al. teach or suggest any other limitations of the rejected claims, Applicants respectfully submit that at least the above-identified feature of the invention is not taught or suggested by Axberg et al., Saegusa et al., or any combination thereof.

In more detail, Axberg et al. discloses a method for producing a coherent view of storage network by a storage network manager using data storage device configuration obtained from data storage devices. In Axberg et al., a distributed storage management program manages a network comprising multiple data storage devices attached to multiple host computer systems. The management program includes a separate agent in each host, and a central manager. The agents gather data and communicate with the manager across a communications path which is independent of the storage network. The manager collates the data from different agents to produce a coherent view of the network. Preferably, each local agent actively builds an internal topological view of the network as seen by its host and collects data such as error events, which

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U.S. Application No.: 09/783,163

it stores in internal data structures. The manager is able to resolve gaps in the information of each agent from information provided by other agents. Preferably, the manager represents the network as a collection of objects of different classes in an object-oriented class library. This collection is graphically displayed in a logical and understandable manner to a user on a display device.

Axberg et al. does not address how I/O commands to access storage resources are received from host computer(s) and does not describe how such requests are handled. Specifically, Axberg et al. does not teach that I/O commands are received by the storage subsystems from the hosts and that the storage subsystem determines whether storage resources requested by the I/O command are usable by searching a device management table; performs the I/O command, if the storage resources requested by the I/O command are usable, otherwise rejects the I/O command; and sends an I/O result to the host computer.

The second reference cited by the Examiner, Saegusa et al., deals with Fiber Channel connection magnetic disk device and fiber channel connection magnetic disk controller. Saegusa et al. fails to remedy the aforesaid deficiency of Axberg et al. by also failing to teach or suggest the above-identified claim limitation. Therefore, the aforesaid limitation is not disclosed by any of the cited prior art references. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Thus, the *prima facie* case of obviousness has not been

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established with respect to claims 1, 6, 10 and 19 and these claims are patentable over combination of Axberg et al. and Saegusa et al.

With respect to the rejection of dependent claims 2-5, 7-9, 11-18 and 20, while continuing to traverse the Examiner's characterization of the teachings of the references used by the Examiner in rejecting these claims, Applicant respectfully submits that the rejection of these claims is rendered moot by the present amendment of the respective parent claims and that these claims are patentable by definition, by virtue of their dependence upon the patentable independent claims 1, 6, 10 and 19. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). MPEP 2143.03.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880.

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PATENT APPLICATION

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/783,163

Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this AMENDMENT UNDER 37 C.F.R. § 1.111 is
being facsimile transmitted to the U.S. Patent and Trademark Office this
28th day of December 2006.


Monica Moreno